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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jesse James

Serial No. 76562049

Anthony M. Keats of Keats McFarland & Wilson LLP for Jesse James.

Toni Y. Hickey, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Grendel, Drost, and Kuhlke, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On November 26, 2003, applicant Jesse James filed an intent-to-use application to register the mark TREINTAS (in standard character form) on the Principal Register for "automobile parts, namely, car wheel rims" in Class 12.¹

The examining attorney refused registration under Section 2(e)(1) on the ground that applicant's mark TREINTAS is merely descriptive of the identified goods. 15 U.S.C. § 1052(e)(1). In addition, the examining attorney

¹ Serial No. 76562049.

also required applicant to submit an accurate translation of the term TREINTAS. When the examining attorney made the refusals to register final, applicant filed a notice of appeal.²

The examining attorney argues that "Treinta" is the Spanish word for "thirty" and, furthermore, "Treintas" "is the foreign equivalent of the word "Thirties." Brief at unnumbered p. 3. The examining attorney then makes the following argument (Brief at unnumbered p. 6):

The examiner presented LEXIS/NEXIS® evidence demonstrating that it is common in the tire/wheel industry for car wheel rims to be referred to and classified by inch size (i.e. twenty four inch, twenty six inch etc.). In relation to the goods, the relevant consuming public will immediately understand that "TREINTAS" means "thirties," and thus describes the rim size. Further, it is customary in this industry for the "inch" sizes grammatically be made "plural," - meaning, the term, even if not grammatically correct is put in a plural format.

Therefore, the examining attorney argues that the mark is merely descriptive of the goods. Furthermore, because the examining attorney submits that the term "Treinta" is translated "thirty" and "treintas" is properly translated "thirties," she also requests that her requirement for an

² Applicant also has another application (No. 76561134) on appeal for the mark THIRTYS for the same goods. It has been refused on a similar ground. However, because of the differences in the record and issues, we have chosen to issue separate opinions in these cases.

accurate translation of the term Treintas" also be affirmed.³

Applicant argues (Reply Brief at 1-2):

The Examining Attorney's conclusion is unpersuasive because it consists only of argument by extrapolation and inference. As such, it is not grounded in evidence of actual use of the applied-for mark in connection with the goods at issue. Specifically, the Examining Attorney argues that because (1) there is some evidence that the term "treintas" has been used colloquially in *other contexts*, (2) rap music lyrics refer to tire rims by size, (3) some car wheel rims are being made in larger sizes, and (4) there are two examples of automobile manufacturers producing thirty inch car wheel rims, that the public will invariably coin a new term, "treintas," and use it descriptively to refer to car tire rims.

Applicant does acknowledge that "treinta" means "thirty" but he disputes that "treintas" means "thirties." Furthermore, applicant submits that "there is no evidence that any entity has ever utilized the designation TREINTAS to advertise or sell car tire rims." Reply Brief at 5.

We begin our analysis by considering whether the examining attorney has made out a prima facie case that the term "thirties" is merely descriptive for tire rims and if the term "treintas" is the foreign equivalent of this term. If that is the case, we must then determine whether applicant has rebutted the examining attorney's case.

³ We have not relied on the examining attorney's citation to a non-precedential decision of this board.

A mark is merely descriptive if it immediately conveys information concerning a quality or characteristic of the product or service. The perception of the relevant purchasing public sets the standard for determining descriptiveness. Thus, a mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service. On the other hand, if a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods or services, then the mark is suggestive.

In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (citations and internal quotation marks omitted). See also In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978) and In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). It is clear that when we are analyzing a mark to determine if it is merely descriptive, we must consider the mark in the context of the identified goods or services and not in the abstract. Abcor, 200 USPQ at 218.

We begin by looking at whether the term "thirties" is merely descriptive of car wheel rims. The term "thirty" is "a cardinal number, 10 times 3." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987).⁴ The same dictionary identifies the plural of this word as "thirties." Rims for cars are often referred to by

⁴ We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

their diameters. See, e.g., *Ward's Dealer Business*, January 1, 2004 ("Auto makers now regularly offer their vehicles with 18-in. wheels, some as large as 20 inches. Custom wheel shops offer 26-in. rims. Meanwhile some 30 inchers were spotted at SEMA's big aftermarket show this year"); *Automotive Industries*, December 1, 2004 ("The new flagship tire, the SP Sports Maxx, is available in 26 sizes in 16-through 22-inch rim diameters"); and *Augusta Chronicle*, April 14, 2004 ("Chris Wise don't like the look of the stock 18-inch rims on his Ford F-150 Lightning pickup truck, so he swapped them out for 20-inch chrome wheels. And when he got tired of those he replaced them with 22-inch rims").

Rim sizes have been getting larger and there is some evidence that 30-inch rims are a relatively new development. *Detroit Free Press*, February 28, 2002 ("At a Las Vegas trade show in October, Japanese tire maker Yokohama showed off the biggest rims yet: 26-inchers, wheels so tall that they came up to mid-thigh level on the scantily dressed tire-show models"); *Ward's Dealer Business*, January 1, 2004 ("Meanwhile some 30 inchers were spotted at SEMA's big aftermarket show this year"); www.philasu.com ("Cadillac also has a concept car called, 'Sixteen' that that was quite a sight to behold. It looks

like it sports thirty-inch rims"); www.hipertekspeed.com ("They had a wild display ranging from the Mitsubishi Eclipse that you can see down the street to the extreme Hummer with a dozen screens and thirty inch rims"). Therefore, the term "30" would describe a car wheel rim that is thirty inches in diameter.

The examining attorney has also included evidence that these rim sizes are often simply referred to by a plural number corresponding to the rim size. A good example can be found at the sounddomain.com website. The page entitled "Toby Brian's Cadillac: Toby's World of 26's" contains a links to a series of photographs of various vehicles with large rims. Some of the captions are as follows:

- Page 18 - Maybach 57 on 22's
- Page 6 - Escalades on Different Giovanna 26's
- Page 7 - Escalades and Denali XL on different Gianelle 26's
- Page 17 - Different Silver and Golden H2's on 26's
- Page 24 - Outcast Big Boi's H2 on 30"!!! Real 40 inch Dayton's!!! Real 56-inch Dayton Spinners. FOR REAL!!!

The examining attorney has also pointed out that there are references in popular music to rim sizes of vehicles that use simply the pluralized number. See, e.g., www.anysonglyrics.com (50 Cent, *True Loyalty*, "Look at them twenty-fours diamonds spin") and www.sing365.com (Insane Clown Posse, *24' on a '84*, "24's on my 84 Regal. I'm

riding down your block with 2 Desert Eagles"). See also
Big Tymers, *Still Fly*:

Cruisin through the parking lot on twenty fours
(Coming Through The Hood On'Em Twenty Fo's)
Cadillac Escalade with the chromed out nose

This evidence supports the conclusion that car rims come in various diameters including thirty-inch diameter. These diameters have been getting larger and the size is often referred to simply by using the number as a plural noun. Therefore, prospective purchasers who encounter the term "Thirties" for rims that are thirty-inches in diameter would immediately understand that the term describes a feature of the goods, i.e., their size.

Before we go on to the foreign equivalent question, we address the question of applicant's goods. Applicant's goods are identified simply as "automobile parts, namely, car wheel rims." During the course of the prosecution of this application, applicant did not amend the identification of goods. Inasmuch as thirty-inch rims are a type of car rim, we must assume that applicant's goods include rims of this size. Weiss Noodle Co. v. Golden Cracknel and Specialty Co., 290 F.2d 845, 129 USPQ 411, 414 (CCPA 1961) ("In deciding whether the mark registered is in fact the name of the product, we look to the description of the products in the registration, not to the registrant's

market practices"). In its response dated January 5, 2005 at unnumbered p. 8, applicant submitted the following statement: "The size of the car wheel rims that Applicant intends to offer in commerce in connection with the applied for mark is 30 inches in diameter."⁵

Next, we address the question of the proper translation of the term "Treintas." Applicant and the examining attorney both agree that the term "Treinta" means "Thirty." Our focus now is the translation of the word "Treintas" with the addition of the letter "S."

The examining attorney argues (Brief at unnumbered p. 3) that "Treintas" is the foreign equivalent of the word "Thirties." The Federal Circuit has recently discussed the applicability of the doctrine of foreign equivalents.

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks...

Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline...

The doctrine should be applied only when it is likely that the ordinary American purchaser would "stop and

⁵ In light of this statement, it is not clear why in his appeal brief (p. 2), applicant maintains that "Applicant has not specified an exact number of inches for such rims, or even whether such rims weigh 30 or more pounds."

translate [the word] into its English equivalent." In re Pan Tex Hotel Corp., 190 USPQ 109, 110 (TTAB 1976).

Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005).

In the Pan Tex Hotel case referred to by the Federal Circuit, the board held that "there can be no doubt that the notation 'LA POSADA' and its English equivalent 'the inn' create different commercial impressions. That is because of the setting in which applicant uses 'LA POSADA,' it is not likely that purchasers would stop and translate said notation into its English equivalent." 190 USPQ at 110. The board pointed out that the term had an "added implication of a home or dwelling, and thus has a connotative flavor which is slightly different from that of the words, 'the inn.'" Id. Recently, the board has held that "the French term MARCHE NOIR is the exact translation of 'Black Market,' but further ... the mark would be translated by those who are familiar with the French language." In re Thomas, Serial No. 78334625, ___ USPQ2d ___ (TTAB April 24, 2006), slip op. at 12. Indeed, the board noted that French was second only to Spanish with the greatest number of speakers in the United States. Id. at 9. Here, these Spanish speakers in the United States would

stop and translate the term TREINTAS when it is used on car rims sold in these countries and understand that the term provides information about the size of the rims.

We add that the doctrine of foreign equivalents is not limited to only marks that are found in foreign dictionaries. See, e.g., Weiss Noodle, 129 USPQ at 413:

As to the dictionary definitions, appellant, while not disputing their existence, argues that there is "no such word as 'HA-LUSH-KA' in the Hungarian language." While the statement is true in the narrowest possible sense, the argument is without substance. The Hungarian word "haluska" is pronounced as though it were spelled "Halushka" (to an English-speaking person) and merely to hyphenate the phonetic version does not destroy its identity.

In the present case, the examining attorney presented the declaration of Steven M. Spar that is set out below:

I, Steven M. Spar, declare that I am fluent in the Spanish Language, that I am a Technical Translator at the United States Patent and Trademark Office, and that the word *treintas* can be translated as "thirties."

Therefore, the examining attorney has provided evidence that the word "Treintas" can be translated as "thirties."⁶

The examining attorney also included some evidence from online translation sites that show that the term "treintas" does appear as a Spanish equivalent of

⁶ Applicant argues (Brief at 3) that this "statement is far from an absolute confirmation that *treintas* means 'thirties.'" However, Mr. Spar's statement is clear that the term "treintas" can be translated as "thirties."

"thirties." See, e.g., www.inglesmundial.com ("in his early thirties" "en los primeros anos de los treintas;" "in his late thirties" "en los ultimos anos de los treintas;" and "in his thirties" "en sus treintas"). Another website, Hispanoteca Lengua y Cultura, makes the following statement: "The introducers of the recent neologism have had to devise one more [sic] a more explicit and eloquent formula: the Thirties or treintas."⁷ One other entry from the website www.education.yahoo.com/reference identifies "treintas" as the inflected form of "treinta," which is itself defined as "thirty."

Based on the above evidence, we hold that the examining attorney has made out a prima facie case that the terms "thirty" and "thirties" are merely descriptive of car wheel rims that are thirty inches in diameter. Furthermore, the evidence, primarily the declaration of Mr. Spar, sets out a prima facie case that the term "Treintas" would be recognized as the term "thirties," at least in the United States.

At this point, we must consider whether applicant has rebutted the examining attorney's prima facie case.

⁷ We add that the quality of this translation in English undercuts the weight that we give it.

Applicant has chosen primarily to attack the examining attorney's evidence. Even if applicant were to "be the first and possibly the only one to utilize this notation in connection with its [goods, this] cannot alone alter the basic descriptive significance of the term and bestow trademark rights therein." In re Gould, 173 USPQ 243, 245 (TTAB 1972). See also In re Sun Microsystems Inc., 59 USPQ2d 1084, 1087 (TTAB 2001). This would be particularly true in this case where the development of thirty-inch rims for cars is apparently a rather new development and there would have been little opportunity for others to use the term previously.

Regarding the translation of the term "Treintas," applicant's brief does contain the following statement: "Applicant's attorneys⁸ are also fluent in Spanish and do not know of any such translation." Brief at 3. We cannot accept that this statement rebuts the examining attorney's prima facie case. First, it appears to be simply argument of counsel and it is unsupported by any evidence in the record. If applicant intended this statement to be evidence, it is untimely. 37 CFR § 2.142(d). It is too late to attempt to introduce evidence for the first time

⁸ We note that only one attorney's name appears at the end of the brief, Anthony M. Keats.

with the appeal brief. See In re Trans Continental Records Inc., 62 USPQ2d 1541, 1541 n.2 (TTAB 2002) (Exhibits from web search engines not considered when submitted for the first time on appeal). Applicant chose not to respond to the examining attorney's evidence by filing a request for reconsideration with additional evidence traversing the examining attorney's evidence that "Treintas" was translated as "thirties."⁹ If applicant had done that, the examining attorney would have had an opportunity to provide additional evidence of the translation of the term. Inasmuch as applicant did not provide this evidence in a timely fashion, it cannot rely on it to rebut the examining attorney's evidence regarding the translation of the term "Treintas."

Also, applicant argues that there is no evidence of record to suggest that Applicant's mark is anything other than an approved foreshortening or whimsical alternative spelling for tire rims of thirty inches or more." Brief at 4. If a misspelling "involves more than simply a misspelling of a descriptive or generic word," it may not be merely descriptive. In re Grand Metropolitan

⁹ The examining attorney referred to the statement (brief at unnumbered p. 4) in applicant's brief as an "unsubstantiated claim" and pointed out that applicant could have submitted a request for reconsideration with appropriate declarations contesting the translation of Mr. Spar.

Foodservices Inc., 30 USPQ2d 1974, 1975 (TTAB 1994)

(Applicant's "MufFuns" (stylized) mark has a different commercial impression than the generic term "muffin"). However, we see nothing whimsical about the term "Treintas." The term "thirties" and its Spanish equivalent "Treintas" is no more whimsical than the references to other rims that were referred to simply as "twentys," "20s," "twenty-fours," or "24s." It is not so much an abbreviation as it is what Judge Rich referred to as follows:

[T]he users of language have a universal habit of shortening full names -- from haste or laziness or just economy of words. Examples are: automobile to auto, telephone to phone, necktie to tie, gasoline service station to gas station. I regard it as inevitable that a gas monitoring badge will be called a gas badge...

Abcor, 200 USPQ at 219 (Rich, J., concurring).

Regarding applicant's allegations that the "evidence of record is clearly insufficient," we simply disagree. The term "30" obviously is exactly descriptive of wheels having a thirty-inch diameter. There is no difference between using the Arabic number "30" or the word "thirty." Both mean exactly the same thing, the number 30. Applicant's identification of goods is not limited and it would include wheels of thirty-inch size. The evidence demonstrates that wheels are frequently referred to by the

plural number of their size. We have no doubt that if prospective purchasers of car rims were to encounter the Spanish term TREINTAS on thirty-inch car rims, they would immediately understand that the term was merely descriptive of these goods. TREINTAS, when used in association with thirty-inch rims, is the type of term that purchasers would stop and translate inasmuch as it would immediately convey significant information to them, i.e., the size of the rims.

We add that the examining attorney's requirement for an accurate translation is also affirmed. The examining attorney has submitted the declaration of Mr. Spar that specifies that the term can be translated as "thirties." Applicant has not rebutted this evidence, and the requirement for a translation is appropriate.

Decision: The examining attorney's refusals to register applicant's mark on the ground that it is merely descriptive of the identified goods and that applicant must provide an accurate translation of the mark are affirmed.